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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,767	01/30/2001	Satoshi Itoi	1512-9	9415

7590 03/24/2005

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EXAMINER

VENT, JAMIE J

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/772,767	ITOI, SATOSHI	
	Examiner	Art Unit	
	Jamie Vent	2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 9 are rejected under 35 U.S.C. 102(e) as being unpatentable by Morito et al (US 2002/0046178).

[claim 1]

In regard to Claim 1, Morito et al discloses a data decoding recording apparatus capable of receiving and decoding a digital broadcast and recording contents of data of the received digital broadcast by a plurality of recording apparatus for different recording media in response to a copy control code included in the received data (Paragraph 0007 describes the copy control information of the recording apparatus) comprising:

- control means for extracting and analyzing the copy control code from the received data and selecting and controlling one or those of said recording apparatus which should execute a recording operation regarding the received data in response to a result of the analysis of the copy control code (Figure 1 copy control signal embedding module controls the extracting of the copy control code from the copy control information database as further described in Paragraph 0008).

[claim 2]

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In regard to Claim 2, Morito et al discloses a data decoding recording apparatus wherein said recording apparatus include a hard disk drive and an optical disk apparatus, and when the copy control code represents a copy-free condition (Paragraphs 0010 – 0011 describes the copy free condition), said control means controls said hard disk drive to record the contents, but when the copy control code represents permission of copying only once, said control means either controls said optical disk drive to record the contents or controls both of said hard disk drive and said optical disk apparatus to record the contents (Paragraphs 0012-0014 describes the control means that controls the event of copy-once signal is detected wherein the signal is recorded onto the appropriate recording medium. Furthermore, it is seen in Figure 4 that recording mediums include optical discs 19 and hard disks 17 wherein the information is appropriately recorded according to the copy control information).

[claim 3]

In regard to Claim 3, Morito et al discloses a data decoding recording apparatus wherein the recording apparatus include a hard disk drive and a video tape recorder (Figure 12b shows hard disk drive 71 and furthermore Figure 12a shows a video recorder 75), and when the copy control code represents a copy-free condition, said control means controls said hard disk drive to record the contents, but when the copy control code represents permission of copying only once, said control means either controls said video tape recorder to record the contents or controls both of said hard disk drive and said video tape recorder to record the contents (Figure 10 shows the process that the recording apparatus determines the copy control information as well as the recording medium to be recorded as further described in Paragraphs 0058-0059. It is noted in Paragraph 0064 discusses the recording mediums that are used for the recording as further seen in Figures 12a-12b).

[claim 4]

In regard to Claim 4, Morito et al discloses a data decoding recording apparatus wherein the recording apparatus include an optical disk apparatus and a video tape recorder, and when the copy control code represents a copy-free condition, said control means controls said video tape recorder to record the contents (Figure 10 step 12 shows the copy free command wherein recording is sent to the recording mediums), but when the copy control code represents permission of copying only once, said control means either controls said optical disk apparatus to record the contents or controls both of said optical disk apparatus and said video tape recorder to record the contents (Figure 10 copy once steps 16 and 21 determine if the copy control code represents the permission of the number of recordings and furthermore is sent to recording to the various recording mediums as seen in step 14).

[claim 5]

In regard to Claim 5, Morito et al discloses a data decoding recording apparatus wherein the recording apparatus include a hard disk drive, an optical disk apparatus and a video tape recorder (Various recording mediums can be used in the recording apparatus depending on the control code information as seen in: Figure 12a shows the video tape recorder, Figure 12b shows the hard disk, and Figure 4 shows optical disks) , and when the copy control code represents a copy-free condition, said control means controls said hard disk drive to record the contents (Figure 10 step 12 shows the copy free command wherein recording is sent to the recording mediums), but when the copy control code represents permission of copying only once, said control means either controls one of said optical disk apparatus and said video tape recorder or both of said optical disk apparatus and said video tape recorder to record the contents or controls all of said hard disk drive, said optical disk apparatus and said video tape recorder to record the contents (Paragraphs 0018-0024 describes the recording permission that permits of the recording onto

the recording mediums that are able to record the information on appropriate recording mediums of optical disks, hard disk, or video recorders).

[claim 9]

In regard to Claim 9, Morito et al discloses a data decoding recording apparatus wherein, when the copy control code represents permission of copying only once, said control means inhibits recording into a partially erased area of a recording medium of any of said recording apparatus and causes data to be recorded continuously to the last end of the recorded data without fail (Figure 10 shows a flowchart regarding the recording apparatus methods pertaining to copy control code information. Furthermore it is seen if the permission of copying once is determined the system records the information onto the data area. As further described in Paragraphs 0057-0060 if the data is determined to be recordable the information is sent to the recording gates and thereby recorded. Furthermore, it is understood that the recorded area to be an area can be re-recorded on or an area that has been previously recorded on and then erased therefore meeting the limitation).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morito et al (US 2002/0046178) in view of Ogino et al (US 6,571,220).

[claim 6]

In regard to Claim 6, Morito et al discloses a data decoding recording apparatus wherein, when the copy control code represents permission of copying only once (Paragraph 0007 describes copy control signal levels including copy once), however, fails to discloses said control means that deletes any unnecessary portion included in the contents in accordance with a rule determined in advance and controls any of said recording apparatus to copy the remaining portion of the contents. Ogino et al discloses a system and method for determining viewing of video information. Furthermore, it is stated in Column 9 Lines 5-53 the extraction/deletion of components that are not related to the control information and furthermore the copying of portions that are to be copy relating to the copy control code (copy once, copy free and copy never). The deletion of portions of the information stream that is not needed for recording or reproducing allows for more storage of component information that needs to be saved, recorded, or reproduced. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the copy control recording apparatus, as disclosed by Morito et al, and incorporate a system that deletes the components of the streams that are not copy protected or needed for recording/reproducing, as disclosed by Ogino et al.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morito et al (US 2002/0046178) in view of Itoh et al (2003/0206632).

[claim 7]

In regard to Claim 7, Morito et al discloses a data decoding recording apparatus wherein said control means controls any of said recording apparatus to record contents whose copy control code represents permission of copying only once (Paragraph 0007 describes the copy control codes which gives permission on reproducing); however, fails to discloses that the copy control

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information does not include a commercial message portion but controls any of said recording apparatus to record contents whose copy control code represents a copy-free condition and which are considered to include a commercial message portion. Itoh et al discloses a system wherein commercials are detected and are not copy protected and therefore become copy-free segment of the data stream as seen in Figure 2b and further described in Paragraphs 0012-0013. By allowing the system to determine that commercials are copy free allows for proper reproduction of content that surrounds the commercials that may have copy control information of copy once and thereby does not discredit the copy control information of the data stream. Therefore, it would be obvious to one of ordinary skill in the art to use a data decoding apparatus with various control codes, as disclosed by Morito et al, and further incorporate a system that determines commercial messages in the data stream and processes the commercials without disrupting the copy condition of the video stream, as further disclosed by Itoh et al.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morito et al (US 2002/0046178) in view of Sawabe et al (US 6,571,055).

[claim 8]

In regard to Claim 8, Morito et al discloses a data decoding recording apparatus wherein, when the copy control code represents permission of copying only once; however, fails to disclose the control means secures two or more sound streams as sound data recording areas for the contents in advance and records the received sound data into the sound data recording area for one of the sound streams but fills the remaining one or more streams with a particular stuffing bit so that sound data may be additionally recorded into the stream or streams filled with the stuffing bits. Sawabe et al discloses an information-recording medium wherein the recorded

information comprises a plurality of video and audio information. Figure 2 shows audio stream for recording the received sound of the system. It is noted in Figure 2 stuffing byte 242g is used for additional information to be recorded or to addition onto the recorded audio stream as disclosed in Column 8 Lines 25-67. The use of a stuffing bit allows for a smooth recording addition onto the previously recorded audio stream instead of re-recording the entire stream. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a data recording apparatus with copy control, as disclosed by Morito et al, and incorporate the use of stuffing bits in the audio signal for allowing for the addition of data into the stream, as disclosed by Sawabe et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Morito (US 6,782,190);
- Kuroda et al (US 2004/0101282).

Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie Vent whose telephone number is 703-305-0378. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jamie Vent
03/15/05


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